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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/654,571
Filing Date: September 01, 2000
Appellant(s): ROWDEN, CHRISTOPHER MORGAN

Kenneth D. Springer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/26/08 appealing from the Office action mailed 11/26/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

Claims 9-16, 18, 19 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5246253	Mykrantz	9-1993
5517419	Lanckton et al.	5-1996
4652239	Brimberg	3-1987

Cronquist. An Integrated System of Classification of Flowering Plants. Columbia University Press. 1981. p. 800.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101 (New Ground of Rejection)

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9-16, 18, 19 and 21 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, a process for producing a landscape plan for a property comprising defining, assigning, determining and producing steps is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11, 15, 16 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Mykrantz (U.S. Patent No. 5, 246, 253) in view of Lanckton et al. (U.S. Patent No. 5, 517, 419).

In regard to claim 9 Mykrantz teaches: a process for producing a landscape plan (e.g., garden planning kit) for a property ("...a garden planning kit of the present invention, indicated generally at 10, is shown to include a worksheet 12 which has been imprinted with horizontally and vertically extending lines to form a grid 14, and an elongate, rectangular template 16 having the openings 18 in it in the shape of the top plan appearance of predetermined sizes of plants for drawing outlines of these plants on the worksheet 12 as they would appear from above the garden ... The three sizes provided allow accurate representation of nearly all common garden plants ... The

worksheet 12 may be light brown in color to resemble the color of the soil in the garden. The location of plants relative each other in the garden to be planted may be represented accurately on the worksheet by using the grid 14 and a ruled longitudinal edge 20 of the template.” – col. 1, ll. 5-20); defining a set of generic plant categories according to plant diameter (... The sizes of the template openings 18 are on generally the same scale as the grid 14 ... three openings 18 of different sizes are provided. The openings 18 have an irregular perimeter which simulates the top plan appearance of the perimeter of plants. The three sizes provided allow accurate representation of nearly all common garden plants. Thus, preliminary dispositions of various types of plants in the garden may be accomplished on the worksheet 12 using the template 16.” – col. 1, ll. 56-68; col. 2, ll. 1-6). It is noted said openings 18, which have respective perimeters, are considered to read on respective plant diameters.

Mykrantz teaches: assigning a symbol (e.g., self-adhesive decal) to each generic plant category (“...A first set 30 and a second set 32 of self-adhesive decals are mounted on sheets of backing paper 36. Decals 30A of the first set 30 are representative of the green leafy portions of plants. However, it is to be understood that the decals 30A generally may represent the base, or lower portion of the plant, whether or not this portion is green or composed of leaves. The decals 30A generally have a color corresponding to the color of a particular type of plant represented, and are imprinted to depict leaves of different types of plants. In the preferred embodiment, decals 30A corresponding to the leafy portions of plants are provided in three different colors and sizes, and five leaf types (e.g., corresponding to fern-like leaves, etc.). The

second set of decals 32A have the color and shape of the blooms of plants. The decals 32A come in many different colors so that the flowers of nearly all types of blooming plants may be depicted. The decals 32A may be transparent and the blooms imprinted on a small area of the decals. ... The bloom decals 32A also come in different sizes and densities corresponding to the appearance of the blooms of various plant species ... decals 32A of the second set come in seven colors, three sizes, five patterns (e.g., having a rose-like bloom, etc.), and two densities." – col. 2, ll. 12-43); determining locations (e.g., on a worksheet) for plants (e.g., represented via respective decals) to be placed on said property and producing the landscape plan by indicating via said symbols locations for said plants on said property ("Referring now to FIG. 2 of the drawings ... The grid 14 and the ruled portion 20 of the template may be used to precisely locate the plants relative one another on the worksheet 12 so that a truly representative appearance of the garden may be achieved. A chart (not shown) is consulted to determine the decals 30A having the appropriate color and size to represent the base or leafy portions of the selected plants. The appropriate decals 30A are removed from their backing paper 36 and adhered to the first overlay 24 at the positions drawn on the underlying worksheet 12. The second overlay 26 is placed over the worksheet 12 and/or the first overlay 24 and the chart is again consulted to determine the decal 32A depicting appropriate color, size, type and density of the bloom for the plants which bloom during a particular time of year..." – col. 2, ll. 44-67; Fig. 2).

However, Mykrantz fails to explicitly teach that said determination of locations for plants to be placed is in reference to a survey of said property. Lanckton et al. teach

producing a survey of a property ("This invention relates generally to surveying and photogrammetric methods of providing terrain data and more specifically to a system for providing precise position data of terrain features quickly and for automatically imaging those features for engineering purposes and remote sensing." – col. 1, ll. 6-10; "It is therefore an object of the present invention to provide identification and documentation of terrain characteristics and features on the terrain for civil engineering purposes. It is a further object of the present invention to provide a terrain mapping system using a global positioning system for accurate positioning of key terrain features." – col. 2, ll. 24-29; "The post-processing workstation is a collection of hardware and software components suitable for the reduction of the raw engineering data, collected during a surveying run, into usable surveying information. The post-processing workstation will allow the operator to extract high accuracy geographic coordinates for features of interest within the collected imagery..." – col. 11, ll. 1-7; "Following post-processing of the raw imagery data, two key products can be produced for delivery to a customer, namely hardcopy engineering plots and softcopy digital vector files..." – col. 12, ll. 42-51). It is noted that civil engineering is considered to include landscaping.

It would have been obvious to one skilled in the art, at the time of the Applicant's invention, to incorporate the teachings of Lanckton et al., which are directed toward attaining accurate positions of key terrain features (Lanckton et al. – col. 2, ll. 27-29), into the method taught by Mykrantz, which is directed toward accurately placing terrain features (e.g., terrain features such as plants; Mykrantz – col. 1, ll. 23-26), because through such incorporation it would allow for a more accurate and realistic looking

landscape plan to be generated via the use of accurate data (e.g., precise position information – Lanckton et al., col. 1, ll. 5-10) which is gathered and processed from the actual landscaping site itself rather than using an approximation (e.g., “The worksheet 12 may be a light brown in color to resemble the color of the soil in the garden.” – Mykrantz, col. 2, ll. 6, 7) of said property.

In regard to claim 10 Mykrantz teaches wherein the generic plant categories are defined according to at least plant width (the rationale disclosed in the rejection of claim 9 is incorporated herein, specifically Mykrantz: col. 1, ll. 56-68; col. 2, ll. 1-6). It is noted that plant width is considered to read on plant diameter.

In regard to claim 11 Mykrantz teaches wherein the generic plant categories are defined according to a leaf texture (Mykrantz – “...decals 30A corresponding to the leafy portions of plants are provided in three different colors and sizes, and five leaf types (e.g., corresponding to fern-like leaves, etc.)...” – col. 2, ll. 12-43; “A chart (not shown) is consulted to determine the decals 30A having the appropriate color and size to represent the base or leafy portions of the selected plants.” – col. 2, ll. 50-53).

In regard to claim 15 Mykrantz teaches wherein the landscape plan includes a legend (e.g., chart) identifying said symbols (Mykrantz – col. 2, ll. 50-53, 58-61).

In regard to claim 16 Mykrantz teaches providing a list of specific plants belonging to each generic plant category (the rationale disclosed in the rejection of claim 1 is incorporated herein, specifically Mykrantz – col. 2, ll. 12-43). It is noted that the respective claim language fails to disclose what exactly constitutes a "list" and thus it is noted a sheet containing a plurality of decals, wherein said decals generally have a

color corresponding to the color of a particular type of plant represented and wherein different types of plants are represented, is considered to read on a list (e.g., visual listing) of plants belonging to each generic plant category.

In regard to claim 21 Mykrantz and Lanckton et al. teach determining the locations for plants to be places on said property with reference to a survey of said property (the rationale disclosed in the rejection of claim 9 is incorporated herein). However, Mykrantz and Lanckton et al. fail to explicitly teach wherein said determination is in accordance with a list of desired landscape characteristics for the property provided by an owner of the property.

Official Notice taken that both the concept and the advantages of allowing a given owner of a property to supply input for and design a landscape plan of a property are known and expected in the art. Thus, it would have been obvious to one skilled in the art, at the time of the Applicant's invention, allow an owner of a property to utilize the method taught by Mykrantz and Lanckton et al. to supply input for and design a landscape plan for their property, because it would allow said property owner to cut out the need for a "middle-man" (e.g., a landscape designer) and would allow said owner to maintain full control over how said landscape was developed. This would result in a more efficient and cost effective process.

Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mykrantz (U.S. Patent No. 5, 246, 253) in view of Cronquist (An Integrated System of Classification of Flowering Plants).

In regard to claim 12 the rationale disclosed in the rejection of claim 9 specific to Mykrantz is incorporated herein. Mykrantz teaches that “The selection of certain plants and their location in the garden depends to a significant degree upon the appearance of the plants during different times of the year” (col. 1, ll. 5-12). However, Mykrantz fails to explicitly teach the use of deciduous and evergreen plants or the use of respective deciduous and evergreen plant categories. Cronquist teaches the classification of a subset of trees into two genera – Aesculus, with deciduous, and Billia, with evergreen (p. 800, ¶ 2).

It would have been obvious to one skilled in the art, at the time of the Applicant's invention, to incorporate the use of deciduous and evergreen plants and the respective classifications of said plants, as taught by Cronquist, into the method taught by Mykrantz, because including said classification of deciduous and evergreen plants would provide a means of better organizing (e.g., classifying) said plants able to be selected, specifically those that either lose or maintain their leaves seasonally, as well as provide a organizing means which is conventional and easily understood. Furthermore, Mykrantz teaches the selection of certain plants and their location in the garden depends to a significant degree upon the appearance of the plants during different times of the year (col. 1, ll. 5-12) and thus through such incorporation the user of said landscaping method would be provided with a more organized and accurate presentation from which to make a selection, wherein said presentation would contain plant information relevant to how said plants react during different times of the year rather than simply listing a plurality of plants without any additional information.

In regard to claim 13 Mykrantz teaches assigning a symbol (e.g., self-adhesive decal) to each generic plant category (col. 2, ll. 12-43). It is noted that the result of said combination is considered to result in said symbols including deciduous and evergreen plants.

Claims 14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mykrantz (U.S. Patent No. 5, 246, 253) and Lanckton et al. (U.S. Patent No. 5, 517, 419), as applied to claims 9-11, 15, 16 and 21, in view of Brimberg (U.S. Patent No. 4, 652, 239).

In regard to claim 14 Mykrantz and Lanckton et al. fail to explicitly teach utilizing hardscape material and symbols for said material in said landscape plan. Brimberg teaches that "The present invention relates to space planning, such as the preparation of floor plans and furniture arrangements in buildings and the landscape planning of yards and the like (col. 1, ll. 13-16, 25-31). Brimberg teaches utilizing hardscape material (e.g., a fence) and symbols for said material in said landscape plan ("...a plurality of graphic symbol elements each formed of a thin, smooth, sheet of static cling vinyl material electrostatically adhered to the storage surface, the elements being respectively in the shapes of views of portions of the boundaries of the area and items to be located therein, and selectively peeling the elements from the storage surface and applying them to the grid of the work surface and arranging the elements on the work surface to define the area and position the items therein." – col. 2, ll. 18-30; "It will be appreciated that for other applications of the space planning system 10, the symbol storage assembly 30 may be provided with different types of graphic symbol elements

38. Thus, in the case of yard or landscape planning, for example, the indicia 36 may include plant elements 43 and elements (not shown) for other types of items which might typically be found in a yard, such as trees, fences, hedges, swimming pools or the like.” – col. 4, ll. 63-68, and col. 5, ll. 1-3).

It would have been obvious to one skilled in the art, at the time of the Applicant's invention, to incorporate the teachings of Brimberg into the method taught by Mykrantz, because through such incorporation it would provide additional structural and operational advantages over traditional space planning systems (Brimberg – col. 1, ll. 56-60) as well provide a means of generating a landscape plan that has a greater degree of detail through the addition of hardscape material, wherein said hardscape material is not limited to only plants but does include plants (Brimberg – col. 4, ll. 63-68; col. 5, ll. 1-3).

In regard to claim 18 the rationale disclosed in the rejection of claim 14 is incorporated herein.

In regard to claim 19 Mykrantz teaches defining a set of generic plant categories according to plant diameter (...The sizes of the template openings 18 are on generally the same scale as the grid 14 ... three openings 18 of different sizes are provided. The openings 18 have an irregular perimeter which simulates the top plan appearance of the perimeter of plants. The three sizes provided allow accurate representation of nearly all common garden plants. Thus, preliminary dispositions of various types of plants in the garden may be accomplished on the worksheet 12 using the template 16.” – col. 1, ll.

56-68; col. 2, ll. 1-6). It is noted said openings 18, which have respective perimeters, are considered to read on respective plant diameters.

(10) Response to Argument

In response to Applicant's remarks that the Examiner admits that Mykrantz does not disclose or suggest any such features in regard to the limitation "includes determining locations for plants to be places on a property with reference to least one image of the property and a survey of the property" it is noted that the Examiner did not admit that Mykrantz fails to disclose or suggest any such features claimed. However, the Examiner did and currently does admit that Mykrantz does not teach all of said claimed features. Lanckton et al. were introduced to address said limitations not explicitly taught by Mykrantz.

Mykrantz teaches determining locations (e.g., on a given overlay) for plants (e.g., represented via respective decals) to be placed on said property and producing the landscape plan by indicating via said symbols locations for said plants on said property ("Referring now to FIG. 2 of the drawings ... The grid 14 and the ruled portion 20 of the template may be used to precisely locate the plants relative one another on the worksheet 12 so that a truly representative appearance of the garden may be achieved. A chart (not shown) is consulted to determine the decals 30A having the appropriate color and size to represent the base or leafy portions of the selected plants. The appropriate decals 30A are removed from their backing paper 36 and adhered to the first overlay 24 at the positions drawn on the underlying worksheet 12. The second overlay 26 is placed over the worksheet 12 and/or the first overlay 24 and the chart is

again consulted to determine the decal 32A depicting appropriate color, size, type and density of the bloom for the plants which bloom during a particular time of year..." – col. 2, ll. 44-67; Fig. 2).

However, Mykrantz fails to explicitly teach that said determination of locations for plants to be placed is in reference to at least one image of said property and a survey of said property. Lanckton et al. teach producing at least one image of said property and a survey of said property ("This invention relates generally to surveying and photogrammetric methods of providing terrain data and more specifically to a system for providing precise position data of terrain features quickly and for automatically imaging those features for engineering purposes and remote sensing." – col. 1, ll. 6-10; "It is therefore an object of the present invention to provide identification and documentation of terrain characteristics and features on the terrain for civil engineering purposes. It is a further object of the present invention to provide a terrain mapping system using a global positioning system for accurate positioning of key terrain features." – col. 2, ll. 24-29; "The post-processing workstation is a collection of hardware and software components suitable for the reduction of the raw engineering data, collected during a surveying run, into usable surveying information. The post-processing workstation will allow the operator to extract high accuracy geographic coordinates for features of interest within the collected imagery..." – col. 11, ll. 1-7; "Following post-processing of the raw imagery data, two key products can be produced for delivery to a customer, namely hardcopy engineering plots and softcopy digital vector files..." – col. 12, ll. 42-51). It is noted that civil engineering is considered to include landscaping.

In response to Applicant's remarks that there is no suggestion to combine the references (Mykrantz and Lanckton et al.) and that the Examiner fails to cite anything at all anywhere in the prior art that suggests the reasons he offers for the proposed modification of Mykrantz it is noted that the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, said suggestion to combine is found both in the references themselves and in the knowledge generally available to one of ordinary skill in the art. Specifically, it would have been obvious to one skilled in the art, at the time of the Applicant's invention, to incorporate the teachings of Lanckton et al., which are directed toward attaining accurate positions of key terrain features (Lanckton et al. – col. 2, ll. 27-29), into the method taught by Mykrantz, which is directed toward accurately placing terrain features (e.g., terrain features such as plants; Mykrantz – col. 1, ll. 23-26), because through such incorporation it would allow for a more accurate and realistic looking landscape plan to be generated via the use of highly accurate data (e.g., precise position information – Lanckton et al., col. 1, ll. 5-10) which is gathered and processed from the actual landscaping site itself rather than using an approximation (e.g., “The worksheet 12 may be a light brown in color to resemble the color of the soil in the garden.” – Mykrantz, col. 2, ll. 6, 7) of said property.

In response to Applicant's remarks that it is apparent that a sheet containing decals which have a color corresponding to a color of a particular type of plant represented cannot reasonably (or even unreasonably) be considered to "read on" a list of plants belonging to a specific category it is noted that the respective claim language fails to disclose what exactly constitutes a "list" and thus it is noted a sheet containing a plurality of decals, wherein said decals generally have a color corresponding to the color of a particular type of plant represented and wherein different types of plants are represented, is considered to read on a list (e.g., visual listing) of plants belonging to each generic plant category.

Mykrantz teaches assigning a symbol (e.g., self-adhesive decal) to each generic plant category ("...A first set 30 and a second set 32 of self-adhesive decals are mounted on sheets of backing paper 36. Decals 30A of the first set 30 are representative of the green leafy portions of plants. However, it is to be understood that the decals 30A generally may represent the base, or lower portion of the plant, whether or not this portion is green or composed of leaves. The decals 30A generally have a color corresponding to the color of a particular type of plant represented, and are imprinted to depict leaves of different types of plants. In the preferred embodiment, decals 30A corresponding to the leafy portions of plants are provided in three different colors and sizes, and five leaf types (e.g., corresponding to fern-like leaves, etc.). The second set of decals 32A have color and shape of the blooms of plants. The decals 32A come in many different colors so that the flowers of nearly all types of blooming plants may be depicted. The decals 32A may be transparent and the blooms imprinted

on a small area of the decals. ... The bloom decals 32A also come in different sizes and densities corresponding to the appearance of the blooms of various plant species ... decals 32A of the second set come in seven colors, three sizes, five patterns (e.g., having a rose-like bloom, etc.), and two densities.” – col. 2, ll. 12-43).

In response to Applicant’s remarks in regard to the Official Notice statement made by the Examiner it is noted that the Applicant fails to specifically point out the supposed errors in the Examiner’s action including stating why the noticed fact is not considered to be common knowledge or well-known in the art. Thus, Applicant’s traverse is not adequate. See MPEP § 2144.03. Instead the Applicant merely poses questions that fail to specifically point out the supposed errors in the Examiner’s action and fail to state why the noticed fact is not considered to be common knowledge or well-known in the art.

As previously disclosed Official Notice taken that both the concept and the advantages of allowing a given owner of a property to supply input for and design a landscape plan of a property are known and expected in the art. Thus, it would have been obvious to one skilled in the art, at the time of the Applicant’s invention, allow an owner of a property to utilize the method taught by Mykrantz and Lanckton et al. to supply input for and design a landscape plan for their property, because it would allow said property owner to cut out the need for a “middle-man” (e.g., a landscape designer) and would allow said owner to maintain full control over how said landscape was developed. This would result in a more efficient and cost effective process.

Regardless of Applicant's failure to adequately traverse said statement of Official Notice, in response to Applicants questions "First, what does it means for a property owner 'to supply input for and design a landscape plan?'" and "Is the Examiner proposing that the owner 'provide input' or that the property owner 'design a landscape plan?'" it is the position of the Examiner that a person or persons placing decals onto a worksheet or worksheets is supplying input to said worksheet(s) as a decal does not place itself onto a worksheet. Said person or persons make decisions which have corresponding results. The conclusion of said input results in a designed landscape plan. The position of the Examiner is not limited to the teachings of Mykrantz. It is the position of the Examiner that resulting survey produced for a customer via the method taught by Lanckton et al. is a result, at least in part, of input made by said customer. Lanckton et al. teaches that "The flexibility of the GIS will allow the format of the plots to be customized to meet individual customer requirements" (col. 12, ll. 52-57).

Regardless of Applicant's failure to adequately traverse said statement of Official Notice, in response to Applicants question "exactly what 'middle-man' is supposedly being cut out by modifying Mykrantz to include this feature?" it is noted that the "middle-man" includes, for example, a hired landscaper who would require a survey of the land they are to work on and who would obtain said survey either by performing said survey themselves or by hiring someone else to generate said survey. Thus, by removing the landscaper from the equation the owner is removing at least one link in the chain.

In response to Applicant's remarks that the Applicant concedes that it is known that plants can be classified as deciduous or evergreen and that the Examiner hardly

needs to cite Cronquist for knowledge that is commonly taught to grade school students the Examiner appreciates the Applicant's admission that said teaching is well known.

As previously disclosed it would have been obvious to one skilled in the art, at the time of the Applicant's invention, to incorporate the use of deciduous and evergreen plants and the respective classifications of said plants, at taught by Cronquist, into the method taught by Mykrantz, because including said classification of deciduous and evergreen plants would provide a means of better organizing (e.g., classifying) said plants able to be selected, specifically those that either lose or maintain their leaves seasonally, as well as provide a organizing means which is conventional and easily understood. Furthermore, Mykrantz teaches the selection of certain plants and their location in the garden depends to a significant degree upon the appearance of the plants during different times of the year (col. 1, ll. 5-12) and thus through such incorporation the user of said landscaping method would be provided with a more organized and accurate presentation from which to make a selection, wherein said presentation would contain plant information relevant to how said plants react during different times of the year rather than simply listing a plurality of plants without any additional information.

In response to Applicant's remarks that the position of the Examiner "is tautological – in effect arguing that it would have been obvious to have modified Mykrantz to include the recited features ... so that Mykrantz would include the received features!" said remarks appear contradictory in light of the Applicant's own admission of what is well known – that it is known that plants can be classified as deciduous or

evergreen. If the Applicant is attempting to challenge the motivation disclosed by the Examiner for said incorporation it is noted that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Applicant's remarks have been fully considered but they are not deemed persuasive.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be sustained.

This Examiner's Answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this Answer exercise one of the following two options to avoid *sua sponte dismissal of the appeal* as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the Primary Examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the Primary Examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/Peter-Anthony Pappas/

Patent Examiner, Art Unit 2628

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Application/Control Number:
09/654,571
Art Unit: 2628

Page 23

Conferees:

/Ulka Chauhan/

Supervisory Patent Examiner, Art Unit 2628

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